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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,723	08/09/2001	Hironori Mizuguchi	Q65824	3958

7590 12/15/2009
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

AMINZAY, SHAIMA Q

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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12/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/924,723	Applicant(s) MIZUGUCHI, HIRONORI	
	Examiner SHAIMA Q. AMINZAY	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

After the Board of Patent Appeals and Interference (BPAI) decision “Examiner Affirmed” (9/24/2009), a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after Allowance. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/2009 has been entered.

Note: In this office action the punctuation colon (“:”) is used as separation between selected lines and paragraph/column (e.g. 2:1-5 means paragraph or column 2, and lines 1-5)

Response to Arguments

1. Applicant's arguments filed 11/24/2009 have been fully considered.

Applicant's arguments with respect to amended claims 1-42 are not persuasive, as applicant states (*Remarks page 23*) “*in view of the Board's remarks on page 5 and 6 in the Decision on Appeal*” applicant added new phrase “*wherein the judging unit judges whether said communication state monitored by said monitor unit is worse than the predetermined state based on a quality of a group of individual communication between*

*the mobile stations and the base station” to the claim limitations of independent claims 1, 6, 14, 22, 27, 35, 37, and 39-42. Examiner disagrees, the BPAI’s decision is not for Applicant to be implementing phrases within the claim language that has **no support in the specification**, the BPAI decision (page 5) states that “Appellant further reasons that because claimed invention requires that the base station monitors the communication state of a plurality of mobile stations, the claimed communication state of said radio communication refers to the **quality of a group of individual communications between the mobile stations and the base station** (App. Br. 24; Reply Br. 4-5). **This argument is not commensurate with the scope of the claims. The claims simply do not address the quality of a group of individual communications.** Instead, claim 1 is broad enough to read on checking the quality of communications with the plural mobile stations individually. **Therefore we do not find the Appellant's argument to be persuasive**”, therefore, as the amendment to independent claims necessitated the new claim rejections under Claim Rejections - 35 USC § 112 First Paragraph (refer to rejection below).*

Claim Rejections - 35 USC § 112

The following is a quotation of the First Paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-42 are rejected under Claim Rejections-35 U.S.C. 112, First Paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In independent claim 1, lines 13-15, the phrase “*wherein the judging unit judges whether said communication state monitored by said monitor unit is worse than the predetermined state based on a quality of a group of individual communication between the mobile stations and the base station*”, similarly the independent claims 6, 14, 22, 27, 35, 37, and 39-42, the phrase “*...based on a quality of a group of individual communication between the mobile stations and the base station*”. The specification does not specify or even mentions any “*...based on a quality of a group of individual communication between the mobile stations and the base station*”.

Claims 2-5, 7-13, 15-21, 23-26, 36, and 38 depend from independent claims 1, 6, 14, 22, 27, 35, and 37 are rejected under the same reasons set forth in claims 1, 6, 14, 22, 27, 35, and 37.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 571-272-7874. The examiner can normally be reached on 7:00 AM -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew D. Anderson can be reached on 571-272-4177. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SHAIMA Q. AMINZAY/
Examiner, Art Unit 2618

December 8, 2009

/Matthew D. Anderson/
Supervisory Patent Examiner, Art Unit 2618